

## REMARKS

Applicant would like to thank the Examiner for discussing the distinguishing characteristics of Applicant's invention in light of the *Chunat* reference as well as acceptable claim language. Applicant has amended the claims in accordance with the discussion, as well as submitted third party publications as Exhibits 1-4, attached hereto, which discuss the drawbacks of having water in contact with an operating engine, as well as the undesirable effects caused by foam within an engine. Additionally, Applicant has resubmitted the amendments submitted with the Amendment filed on May 7, 2009 for the same reasons as noted in that Amendment, since these amendments were not subsequently entered by the Examiner.

Claims 1-10, 14-20, and 35-50 are pending. Claims 1-10 have been withdrawn from examination. Claims 11-13 and 21-33 have been canceled, and claim 34 has not been entered. Applicant has currently amended independent claims 14, 35, 41 and 46 to recite that the metal substrate is within an engine, as well as that the carrier solution and the target fluid are essentially free of water. Support for these amendments can be found in paragraphs [0020] and [0012], respectively.

## 35 U.S.C. § 103

### Response to 35 U.S.C. § 103(a) Rejection in Light of U.S. Patent No. 4,060,433 ("*Chunat*")

Claims 14-17, 20, 35-38, 41-43, and 46-48 have been initially rejected as being obvious over *Chunat* under 35 U.S.C. § 103(a). The Examiner correctly notes that *Chunat* fails to teach that its solution may be applied to an engine, as well as an engine under engine operating conditions. However, Applicant respectfully disagrees with the Examiner's assertion that it would have been obvious to apply the foaming solution of *Chunat* onto a metal surface that is part of an engine under engine operating conditions, and in support, offers the attached third party publications

(attached as Exhibits) that discuss the hazards of applying aqueous solutions to an engine under engine operating conditions (See Exhibits 1-2), as well as discuss the hazards of foam within an engine under engine operating conditions (See Exhibits 3-4).

*Chunat* discloses a foaming solution sprayed onto the outer surfaces of a metal component. Therefore, *Chunat* does not teach application of its solution within an engine, and Applicant respectfully submits that not only would it not be obvious for one of ordinary skill in the art to apply the solution of *Chunat* within an engine under engine operating conditions, it would be catastrophic to apply the solution taught in *Chunat* to a metal substrate within an engine under engine operating conditions because aqueous based solutions as well as foaming solutions greatly inhibit engine reliability.

**Water Based Solutions have Detrimental Effects to Engines under Engine Operating Conditions**

Regarding water-based solutions in contact with metal substrates within an engine under engine operating conditions, Applicant submits that those of ordinary skill in the art would recognize that introducing water into an engine would cause a multitude of problems. See Exhibit 1 ("Water is one of the most destructive contaminants in most all lubricants. It attacks additives, induces base oil oxidation and interferes with oil film production."). See Exhibit 2 ("Do not spray [the engine] with cold water to avoid cracking the engine block or other engine components. . . . Never wash or rinse the engine while it is running; water in the running engine may cause internal damage."). Therefore, Applicant respectfully submits that those of ordinary skill in the art would not find it obvious to introduce the aqueous solution of *Chunat* to a metal substrate within an engine under engine operating conditions.

**Foam within an Engine has Detrimental Effects to Engines under Engine Operating Conditions**

Foam contains air, and those of ordinary skill in the art would recognize that "[a]ir can weaken oil films, increase heat, induce oxidation, cause cavitation and interfere with oil flow; all catastrophic to the bearing. Aeration and foam can also incapacitate the effectiveness of oil slingers/flingers, ring oilers and collar oilers." Exhibit 3. As further evidence that those of ordinary skill in the art recognize the undesirableness of foam within an engine, Applicant submits it is common for motor oil producers to add anti foaming agents into their products. See Exhibit 4 ("lower foaming means better driveability"). Consequently, Applicant respectfully submits that those of ordinary skill in the art would not find it obvious to introduce a foaming solution as taught by *Chunat* to a metal substrate within an engine under engine operating conditions.

The present claims, as amended, define a phosphorous-containing solution operable to create a phosphate-metal layer on a metal substrate within an engine under engine operating conditions. As *Chunat* teaches the use of a foaming solution to be sprayed on the outer surface of a stationary metal component, and those of ordinary skill in the art would understand that none of the embodiments taught by *Chunat* would be successful within an engine under engine operating conditions, Applicant respectfully asserts that the above referenced claims are not obvious in light of *Chunat*. As all of the pending dependent claims incorporate the same limitations of independent claims thought to be allowable, Applicant respectfully requests the Examiner to withdraw the rejection based off of *Chunat* and allow all of the previously rejected claims.

## CONCLUSION

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicant's present invention have been made by Applicant. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinctions between Applicant's invention to be unobvious in view of the prior art.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention, which render it patentable, being only examples of certain advantageous features and differences that applicant's attorney chooses to mention at this time.

Reconsideration of the application and allowance of all of the claims are respectfully requested. In view of the foregoing Response, applicant respectfully submits that all of the claims are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance. Should further discussion regarding the application be desired by the Examiner, a telephone conference is respectfully requested. I can be reached at (713) 221-3306. Applicant respectfully requests a two-month extension of time, and has submitted the necessary payment via credit card. If Applicant is mistaken in regards to the payment amount, the Commissioner is authorized to

charge BRACEWELL & GIULIANI LLP, Deposit Account 50-0259 (27435.002) in the amount of any deficiency.

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Respectfully submitted,



Constance Gall Rhebergen, Reg. No. 41,267

BRACEWELL & GIULIANI LLP

P.O. Box 61389

Houston, Texas 77208-1389

(713) 221-3306 direct phone

(713) 222-3291 direct facsimile

[Constance.Rhebergen@bgllp.com](mailto:Constance.Rhebergen@bgllp.com)

Attorney for Applicant